

REMARKS

The present Amendment is in response to the Office Action (hereinafter referred to as the "Office Action") mailed December 21, 2006. By this paper, no claims are added, claim 15 is amended, and claim 5 is cancelled. Claims 1-4 and 6-32 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action. Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. General Considerations

Applicants note that the remarks and amendments, or a lack of remarks, herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; as to the whether any references were properly combined, or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Further, Applicants reserve the right to challenge the purported teaching and prior art status of, as well as the motivation to combine, the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicants, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Specification

The Office Action objects to page 8 of the specification and requests that Applicants amend paragraph [0025]. As noted above, Applicants have amended paragraph [0025] as directed in the Office Action and request that the objection be withdrawn.

Applicants further note that an amendment has been made to paragraph [0061] in order to correct a typographical error. No new matter is believed to have been added by this amendment.

III. 35 U.S.C. § 112, First Paragraph

The Office Action rejects 5 under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. Applicants note that this rejection is now moot in light of cancellation to claim 5 and ask that this rejection be withdrawn.

IV. Rejection Under 35 U.S.C. § 103

A. Claims 1-4, 6-12

The Office Action rejects claims 1-12 under 35 U.S.C. § 103 as being unpatentable over United States Patent No. 6,580,531 to Swanson et al. ("Swanson") in view of United States Patent No. 4,911,516 to Burton et al. ("Burton"). Claim 4 was further rejected in view of United States Patent No. 5,575,998 to Thatcher ("Thatcher"). Applicants respectfully traverse this characterization for at least the reasons that will now be discussed.

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Office Action to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP § 2143*.

As originally filed, claim 1 discloses a method of testing an optical subassembly of an optoelectronic device that comprises in part "forming a temporary electrical connection between a

secondary circuit and the electrical interface of the tester apparatus.” (Emphasis added). In other words, the method of claim 1 recites that a temporary electrical connection be formed between the test apparatus and a secondary circuit.

However, the Office Action has failed to identify that Swanson or Burton, either singularly or in combination, teach such a connection between a secondary circuit and the test apparatus. In fact, page 3 of the Office Action, where the Examiner recites where in the purported combination of Swanson and Burton all the elements of claim 1 are allegedly found, does not even make mention of a secondary circuit. Page 3 alleges that a tested board 10 of Swanson is a test circuit, but nowhere is there any mention of a secondary circuit that could be temporarily connected with a test apparatus.

As to the alleged motivation for the purportedly obvious modification of testing system of Swanson, the Office Action has asserted that it would be obvious to modify the testing apparatus of Swanson by temporarily connecting the test circuit and the subassembly before integration in order to test and replace any defective parts. Notwithstanding this assertion, the Office Action has failed to show that testing apparatus of Swanson would still be functional with such a temporary connection. For example, Swanson teaches that the testing system disclosed is meant to test optical transceiver boards that are already integrated. In other words, the Office Action has not shown how the optical subassembly as illustrated in figures 1 and 2 of Swanson could be temporarily connected to the other circuit elements of that board. There is simply no interface disclosed in Swanson that would allow such temporary connection while still having board 10 work as it is described in Swanson.

Further, the question is whether one of skill in the art, after having read Swanson, would think to modify the testing system and apparatus with Burton. However, one of skill in the art would not find it necessary to modify Swanson as the test apparatus is configured to work well with integrated transceiver boards. The teaching of Burton as related to packaging techniques for transceivers would not motivate one of skill in the art to modify Swanson.

Accordingly, as even the purported combination of Swanson and Burton fails to teach or suggest all of the claim limitations of claim 1, and because the Office Action has failed to establish the existence of a suggestion or motivation to modify the Swanson test apparatus in the purportedly obvious fashion, a *prima facie* case of obviousness has not been established. Therefore the Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

Dependent claims 2-4 and 6-12 depend from claim 1 and are therefore patentable over the purported combination of Swanson and Burton for at least the reasons discussed in relation to claim 1. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn for these claims. Applicants note that rejection to claim 5 is moot in light of the cancellation of claim 5 and should be withdrawn.

B. Claims 13-24

The Office Action rejects claims 13-24 under 35 U.S.C. § 103 as being unpatentable over Swanson in view of Burton. Claims 14-17 are further rejected in view of United States Patent No. 6,765,396 to Barror ("Barror"). Applicants respectfully traverse this characterization for at least the reasons that will now be discussed.

Claim 13 as filed discloses an optical subassembly apparatus comprising in part "means for temporarily placing the optical subassembly in electrical connection with the electrical interface." In other words, the optical subassembly testing apparatus requires means for temporarily connecting the optical subassembly with the electrical interface.

The Office Action, however, is silent on which element of Swanson or Burton, either singularly or in combination, is the recited means for temporarily placing the optical subassembly in electrical combination with the electrical interface. On page 3 the Office Action admits that Swanson differs from the claimed invention in that Swanson does not specifically disclose that the connection between the optical subassembly and the electrical interface is temporary. Accordingly, Swanson does not teach the required means for temporarily placing the optical subassembly in electrical connection with the electrical interface.

The Office Action then cites Burton to show that testing of an optical subassembly before integrating the subassembly with other optical device circuit elements. However, even assuming that Burton teaches such a proposition, the Office Action still has not pointed where or how Burton discloses the recited means for temporarily placing the optical subassembly in electrical connection with the electrical interface.

As to the alleged motivation for the purportedly obvious modification of testing system of Swanson, the Office Action has asserted that it would be obvious to modify the testing apparatus of Swanson by temporarily connecting the test circuit and the subassembly before integration in

order to test and replace any defective parts. Notwithstanding this assertion, the Office Action has failed to show that testing apparatus of Swanson would still be functional with such a temporary connection. For example, Swanson teaches that the testing system disclosed is meant to test optical transceiver boards that are already integrated. In other words, the Office Action has not shown how the optical subassembly as illustrated in figures 1 and 2 of Swanson could be temporarily connected to the other circuit elements of that board. There is simply no interface disclosed in Swanson that would allow such temporary connection while still having board 10 work as it is described in Swanson.

Further, the question is whether one of skill in the art, after having read Swanson, would think to modify the testing system and apparatus with Burton. However, one of skill in the art would not find it necessary to modify Swanson as the test apparatus is configured to work well with integrated transceiver boards. The teaching of Burton as related to packaging techniques for transceivers would not motivate one of skill in the art to modify Swanson.

In addition, the Office Action admits that Swanson and Burton do not disclose a clamping assembly as recited in claims 15-17 but instead alleges that this element is disclosed by Barror. However, as with the Burton reference, the Office Action has failed to show that the testing apparatus of Swanson would still be functional with such a clamping assembly. As discussed above, Swanson teaches that the testing system disclosed is meant to test optical transceiver boards that are already integrated. The Office Action has failed to show where or how such a clamping assembly could be integrated into the testing apparatus of Swanson. There is simply no place shown in figures 1 and 2 of Swanson where a clamping assembly could be implemented as is taught in the pending application and claimed in claims 15-17.

Nevertheless, even if there is motivation to combine Swanson and Burton and even if the combination of Swanson and Burton teaches the recited means for temporarily placing the optical subassembly in electrical connection with the electrical interface, which the Applicants do not concede is the case, the purported combination of Swanson and Burton still does not teach a base member or a test circuit disposed on the base member as recited in claim 13 as admitted by the Office Action.

In connection with the foregoing, Applicants note that the Office Action appears to be taking the view that the "base member" and "test circuit disposed on the base member" recited in claim 13 is inherent in Swanson. Applicants respectfully note, however, that inherency is not

readily established. For example, as noted in MPEP § 2112, the Office Action must provide rationale or evidence showing inherency. In particular, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described by the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient’.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Finally, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Office Action has not met this burden in showing that a base member is inherent in Swanson.

In light of the foregoing, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 13 at least because the Office Action has not established that the references, either alone or in combination, teach or suggest all the limitations of claim 13, and because the Office Action has failed to establish the existence of a suggestion or motivation to modify the Swanson test apparatus in the purportedly obvious fashion. Applicant thus respectfully submits that the rejection of claim 13 should be withdrawn.

Dependent claims 14-23 depend from claim 13 and are therefore patentable over the purported combination of Swanson and Burton for at least the reasons discussed in relation to claim 13. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn for these claims. Applicants note that an amendment has been made to claim 15 in order to correct an antecedent basis error.

C. Claims 25-32

The Office Action rejects claims 25-32 under 35 U.S.C. § 103 as being unpatentable over Swanson in view of Burton and further in view of Barror. Applicants respectfully traverse this characterization for at least the reasons that will now be discussed.

As to the alleged motivation for the purportedly obvious modification of testing system of Swanson, the Office Action has asserted that it would be obvious to modify the testing apparatus of Swanson by temporarily connecting the test circuit and the subassembly before integration in order to test and replace any defective parts. Notwithstanding this assertion, the Office Action has failed to show that testing apparatus of Swanson would still be functional with such a temporary connection. For example, Swanson teaches that the testing system disclosed is meant to test optical transceiver boards that are already integrated. In other words, the Office Action has not shown how the optical subassembly as illustrated in figures 1 and 2 of Swanson could be temporarily connected to the other circuit elements of that board. There is simply no interface disclosed in Swanson that would allow such temporary connection while still having board 10 work as it is described in Swanson.

Further, the question is whether one of skill in the art, after having read Swanson, would think to modify the testing system and apparatus with Burton. However, one of skill in the art would not find it necessary to modify Swanson as the test apparatus is configured to work well with integrated transceiver boards. The teaching of Burton as related to packaging techniques for transceivers would not motivate one of skill in the art to modify Swanson.

In addition, the Office Action admits that Swanson and Burton do not disclose a clamping assembly as recited in claim 25, but instead alleges that this element is disclosed by Barror. However, as with the Burton reference, the Office Action has failed to show that the testing apparatus of Swanson would still be functional with such a clamping assembly. As discussed above, Swanson teaches that the testing system disclosed is meant to test optical transceiver boards that are already integrated. The Office Action has failed to show where or how such a clamping assembly could be integrated into the testing apparatus of Swanson. There is simply no place shown in figures 1 and 2 of Swanson where a clamping assembly could be implemented as is taught in the pending application and claimed in claim 25.

Nevertheless, even if there is motivation to combine Swanson, Burton and Barror and even if the combination of Swanson, Burton and Barror has been properly combined, which the

Applicants do not concede is the case, the purported combination of Swanson, Burton and Barror does not teach a base member or a test circuit disposed on the base member as recited in claim 25 as admitted by the Office Action.

In connection with the foregoing, Applicants note that the Office Action appears to be taking the view that the “base member” and “test circuit disposed on the base member” recited in claim 25 is inherent in Swanson. Applicants respectfully note, however, that inherency is not readily established. For example, as noted in MPEP § 2112, the Office Action must provide rationale or evidence showing inherency. In particular, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original). Moreover, the Court of Appeals for the Federal Circuit has noted that “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described by the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient’.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Finally, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Office Action has not met this burden in showing that a base member is inherent in Swanson.

In light of the foregoing, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 25 at least because the Office Action has not established that the references, either alone or in combination, teach or suggest all the limitations of claim 25, and because the Office Action has failed to establish the existence of a suggestion or motivation to modify the Swanson test apparatus in the purportedly obvious fashion. Applicant thus respectfully submits that the rejection of claim 25 should be withdrawn.

Dependent claims 24-32 depend from claim 25 and are therefore patentable over the purported combination of Swanson, Burton, and Barror for at least the reasons discussed in

relation to claim 25. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn for these claims.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended or presently pending are in allowable form and that every issue raised by the Office Action has been addressed. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorneys.

Dated this 21st day of March, 2007.

Respectfully submitted,

A handwritten signature in black ink that reads "Shane K Jensen". The signature is written in a cursive, flowing style.

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